

REMARKS

Claims 1-4 are canceled.

Claims 5 and 7 are amended to clarify that the claims are directed to an image forming system comprising an image-forming apparatus and a toner and claims 6 and 8 are amended to consistent with claims 5 and 7. No new matter has been added.

In the Advisory Action dated March 30, 2006, the Examiner states that the proposed amendments to claims 5 and 7 raise the issue of new matter and rejections under 35 U.S.C. § 112, 1st paragraph, for lack of written description regarding the newly added recitation of an "image forming system" in the originally filed specification. It is the Examiner's position that Applicants have not indicated where in the originally filed specification there is antecedent basis for the term "image forming system" and the proposed amendment also raises an issue under 35 U.S.C. § 112, 2nd paragraph, because it is not clear what is meant by the term "system", which is not defined in the originally filed specification.

Applicants respectfully submit that the term "image forming system" is not new matter since it merely renames the invention as a system comprising an image forming apparatus and toner (see MPEP §2163.07(I)) and since the term "system", which is defined as a group of interrelated, interactive or interdependent constituents forming a complete whole or a functionally related group of elements (see Webster's II New College Dictionary, 3rd Ed.) is to be given its plain and ordinary meaning as would be understood by those of ordinary skill in the art. There is no questions that the original specification adequately describes the recited elements of the invention, and there is no legal requirement that the exact same phraseology by used in the claims, as in the specification, to comply with section 112's so-called written description requirement.

After entry of this amendment, claims 5-8 will be pending in the application.

I. Response to Objections to the Disclosure

At pages 3 and 4 of the Office Action, the disclosure is objected to because not all of the trademarks were capitalized and spelled correctly in the substitute specification filed on September 28, 2005.

Applicants submitted a Substitute Specification on March 15, 2006, amending the disclosure by correcting the trademarks. However, in the Advisory Action dated March 30, 2006, the Examiner stated that the substitute specification submitted on March 15, 2006, does not show changes relative to the immediate prior version of the specification on record, which is the substitute specification filed on September 28, 2005 that was entered by the Office.

In response, Applicants submit a third Substitute Specification based on the Substitute Specification filed on September 28, 2005 and entered by the Office. No new matter has been added.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

II. Response to Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

At page 5, paragraph 6 of the Office Action, claims 5-8 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Specifically, the Examiner contends that claims 5 and 7 are indefinite in the phrase “[a]n image-forming apparatus comprising ... a toner,” because the structural relationship between

the apparatus and the toner is not clear. The Examiner further states that the toner is merely a material that is worked upon by the apparatus, rather than a structural element of the apparatus.

In response, Applicants have amended claims 5 and 7 to clarify that the claims are directed to an "image forming system" comprising both the apparatus and the toner. As previously mentioned, the term "image forming system" is not new matter since it merely renames the invention.

Applicants submit that claims 5-8 particularly point out and distinctly claim the subject matter which Applicants regard as the invention, and thus respectfully request reconsideration and withdrawal of this rejection.

III. Response to Objections to the Claims

At page 5, paragraph 7 of the Office Action, claim 7 is objected to because the term "G(t=0.01)[Pa" is missing a closing bracket.

Applicants have amended claim 7 by adding the closing bracket, and thus respectfully request reconsideration and withdrawal of this objection.

IV. Response to Claim Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

At pages 6-9 of the Office Action, claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. 103(a) as allegedly obvious over WO 02/084408 A1 (Matsumura).

Claims 1 and 3 have been canceled, rendering this rejection moot.

V. Response to Claim Rejections Under 35 U.S.C. § 102(e)

At pages 10 and 11 of the Office Action, claims 1-4 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. 2005/0100807 AI (Yamazaki), as allegedly evidenced by Applicants' admissions I.

Claims 1-4 have been canceled, rendering this rejection moot.

VI. Response to Double Patenting Rejection

At pages 12-16 of the Office Action, claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of co-pending U.S. Pat. Appln. No. 10/787,394.

Claims 1-4 have been canceled, rendering this rejection moot.

VII. Conclusion

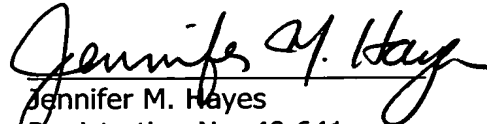
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. § 1.114(c)
U.S. App. Ser. No. 10/787,389

Atty. Dckt. No. Q80155

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: May 15, 2006